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ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/666,655	BLOOMFIELD, MARK E.
	<b>Examiner</b>	<b>Art Unit</b>
	Jon Chang	2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-41 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-41 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 September 2000 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features for claims 6-15, 23-2 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 16, 18-22, 25-29, 32 and 35-39 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,081,629 to Browning.

As to claim 1, Browning discloses a hand-held control device for controlling a terminal ("terminal" is interpreted in the broad sense. The personal computer or the network computer, column 3, lines 31-32, are considered terminals) connectable by a

communications network to an addressed resource (column 2, lines 15-16), the device comprising:

address input means for scanning a text address of the resource (column 2, lines 29-32; column 2, lines 42-45); and

command output means for uploading address information from the device to the terminal and causing the terminal to connect to the addressed resource (column 3, lines 26-28; column 3, lines 36-44).

With regard to claim 2, the recognition means for recognizing the nature of the addressed resource from the format of the scanned text address is considered inherent to Browning's device. Note that the device will automatically connect to the address (e.g., Fig.5, elements 52, 56 and 58; column 4, lines 31-37). Note further that the address can pertain to a world wide web page or an e-mail server (column 4, lines 44-50). Therefore the device can at least recognize the nature of the addressed resource (e.g., web or e-mail server). Since it only scans and recognizes text prior to making the connection, it must do this (i.e., recognize the nature of the addressed resource) by the format of the text. As is well known, web and e-mail addresses have particular, but different formats.

As to claim 3, Browning discloses a device according to claim 2, further comprising means for retrieving an application launch code suitable to launch an application on the terminal appropriate to the nature of the addressed resource (column 4, lines 60-64).

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Regarding claim 16, Browning discloses a device according to claim 1, further comprising a head end and an elongate barrel terminating distally in the head end to provide a generally pen-like size and shape (Figs. 1A and 1B).

As to claim 18, Browning discloses a device according to claim 1, further comprising means for storing a plurality of resource addresses (column 4, lines 3-4).

Regarding claim 19, Browning discloses a device according to claim 18, further comprising (i) means for displaying all of the stored resource addresses (column 2, lines 58-60), and (ii) means for selecting an appropriate one of the stored and displayed resource addresses (column 4, lines 29-30).

Referring to claim 20, Browning discloses a device according to claim 1, wherein the command output means uploads information to the terminal by wireless transmission (column 3, lines 29-30).

Regarding claim 21, Browning discloses a device according to claim 20, wherein the command output means includes an IR or RF transmitter (column 3, lines 29-30).

As to claim 22, Browning discloses a device according to claim 1, further comprising display means for providing a confirmatory display of a scanned address (column 2, lines 58-62).

As to claim 25, Browning discloses a system comprising:  
a hand-held control device (Figs. 1A and 1B) for controlling a terminal connectable by a communications network to an addressed resource, the device including (i) address input means for scanning a text address of the resource (column 2, lines 29-32; column 2, lines 42-45), and (ii) command output means for uploading

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address information from the device to the terminal and causing the terminal to connect to the addressed resource (column 3, lines 26-28; column 3, lines 36-44); and

a terminal for downloading address information from the device (colun 3, lines 30-33).

As to claim 26, Browning discloses a system according to claim 25, wherein the terminal includes means for recognizing, verifying and acting upon command data (i.e., via the companion software communications agent, column 3, lines 30-44).

Regarding claims 27-29, the discussions above for claims 1-3 are applicable.

Regarding claim 32, see relevant remarks provided for claim 1.

With regard to claims 35-37, the discussions above for claims 20, 22 and 26 are applicable.

As to claim 38, Browning discloses a method according to claim 37, wherein the addressed resource is an Internet resource and the terminal launches a browser and uses that browser to load the Internet resource (column 4, lines 41-47; column 4, lines 60-64).

As to claim 39, Browning discloses a method according to claim 38, further comprising displaying, viewing and optionally interacting with the Internet resource (column 4, lines 63-64; interacting is considered an inherent use of the browser).

4. Claims 23, 24 and 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,456,749 to Kasabach et al. (hereinafter "Kasabach").

As to claim 23, Kasabach discloses a hand-held control device for controlling a terminal, the device comprising:

command output means for uploading a text or graphics file from the device to the terminal (column 2, lines 1-3; column 5, lines 35-38; column 8, lines 8-10);

sensor means for sensing movement of the device when the device is used as a writing or drawing instrument (column 4, lines 58-65); and

means for generating the text or graphics file as a user writes or draws with the device (column 5, lines 35-38; column 8, lines 8-10).

Regarding claim 24, Kasabach discloses a device according to claim 23, connectable by a communications network to an addressed resource (column 5, lines 40-51), wherein the command output means includes means for causing the terminal to connect by a communications network to an addressed resource and to convey the text or graphics file as message information to that resource (column 7, lines 1-7).

Regarding claims 40 and 41, see the remarks provided above for claims 23 and 24.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 4-5, 17 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browning.

Regarding claim 4, Browning does not disclose that the device further includes means for appending the application launch code to the address information before upload to the terminal. However, the Examiner takes Official Notice that appending application launch code to address information is well known in the art. It would have been obvious to do this in Browning's system because, the particular program to be launched is associated with the address information, and appending would allow more efficient launching of the application. Further, it would have been obvious to append this before upload to the terminal to alleviate processing by the terminal.

Regarding claim 5, Browning also does not disclose means for storing the address information with an associated application launch code until upload to the terminal. The Examiner takes Official Notice that storing address information with associated launch code is well known in the art. It would have been obvious to do this, to provide quick launching of the application, as by use of a lookup table for example.

With regard to claim 17, Browning discloses device according to claim 16, wherein the address input means includes a scanner (column 2, lines 41-42), but does not discloses that the head end defines a surface that is obliquely angled to the longitudinal axis of the barrel such that the surface including the scanner. Browning's surface appears to be approximately parallel to the longitudinal axis. However, to have the surface at any particular orientation to the longitudinal axis is seen as a decision

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based upon designer preference. The designer would utilize a particular orientation based on a particular need or application, or perhaps based upon consumer desires.

With regard to claims 30-31, see the discussion provided above for claims 4 and 5.

7. Claims 6-15 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Browning and Kasabach.

Regarding claim 6, Browning does not disclose that the device further comprises control means responsive to the orientation and/or movement of the device. However, Kasabach teaches a hand-held control device, which comprises such control means (column 4, line 58 to column 5, line 1). Implementing Kasabach device's writing capabilities and features in Browning's device would have added greater functionality and versatility to Browning's device. Note that Kasabach's device is also for the purpose of connecting to the Internet as well as send and receive e-mail (column 5, lines 48-51), the same purpose as Browning's device. Therefore, it would have been obvious to one of ordinary skill in the art to modify Browning's device to include Kasabach's teachings.

As to claim 7, Kasabach does not explicitly mention that the control means includes a tilt switch or an array of tilt switches arranged to sense orientation of the device. Tilt switches for sensing orientation are exceedingly old and well known in the art (Official Notice). They provide a simple way for determining orientation. Therefore it

would have been obvious to one of ordinary skill in the art to modify the Browning-Kasabach device to utilize tilt switches instead of accelerometers.

Regarding claim 8, Kasaback further discloses that the control means includes an accelerometer or an array of accelerometers arranged to sense orientation or movement of the device (column 4, line 66 to column 5, line 1).

Regarding claim 9, in modifying Browning's device according to Kasabach (see discussion for claim 6), the control means would be arranged to sense movement of a head end of the device (via accelerometers) when the device is used as a writing instrument (note Kasabach contemplates use of the device as a writing instrument, column 2, lines 1-2; column 3, line 1).

As to claim 10, Kasabach further discloses that the control means activates a function in accordance with the orientation or movement of the device (column 6, lines 66-67).

As to claim 11, Kasabach further discloses that the control means activates a function in accordance with a predetermined sequence of orientations or movements of the device (column 7, lines 1-13).

As to claim 12, Kasabach further discloses that the head end of the device includes a stylus (column 3, lines 1-4).

As to claim 13, Kasabach's stylus includes a mechanical pencil (column 3, lines 3-4), the "lead" of which is inherently retractable.

As to claim 14, Kasabach further discloses means for generating a text file as a user writes with the device (column 8, lines 8-10).

As to claim 15, Kasabach discloses means for generating a graphics file as a user writes or draws with the device (column 5, lines 35-38; the file is considered inherent when storing).

With regard to claim 33, see the discussion above for claim 6.

With regard to claim 34, remarks similar to those provided above for claims 9 and 14 are applicable.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon Chang whose telephone number is (703)305-8439. The examiner can normally be reached on M-F 8:00 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703)308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9314 for regular communications and (703)872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4700.



Jon Chang  
Primary Examiner  
Art Unit 2623

Jon Chang  
July 12, 2003